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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,683	06/24/1999	GREGOR CEVC	500.1007	2670

23280 7590 01/03/2003

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EXAMINER

KISHORE, GOLLAMUDI S

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 01/03/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/284,683

Applicant(s)

Cevc

Examiner

Gollamudi Kishore

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 16, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-33 and 49-90 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-33 and 49-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

**The request for the extension of time and amendment filed on 10-16-02 are acknowledged.**

**Claims included in the prosecution are 22-33 and 49-90.**

#### ***Claim Rejections - 35 U.S.C. § 112***

**1. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

**2. Claims 22-33 and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**The terms such as ‘for example water’ and ‘especially’ render Claim 22 indefinite.**

**‘Fine’ in fine pored filter in claim 24 is indefinite; fine is a relative term. Applicant’s arguments that the term is known in the art are not found to be persuasive since no evidence is presented to show that pores of 1-200 nm are considered as fine pores.**

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**The amendment to claim 33 did not cure the deficiency. This claim is dependent from claim 22 and claim 22 does not recite a lyophilisate. How is this lyophilisate prepared and from where?**

**Claim 52 is not further limiting claim 31 in terms of pore sizes. Applicant has not addressed this issue sufficiently. The upper limit of the pore size recited in claim 52 is 0.15 whereas the upper limit in claim 31 is 0.8.**

***Claim Rejections - 35 U.S.C. § 102***

- 2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless —**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

- 3. Claims 22-33 and 49-90 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 475 160 of record.**

**EP discloses instant composition containing a drug, an amphiphilic lipid and a surfactant in instant amounts and a method of preparation ( see the entire document).**

**Applicant's arguments have been fully considered, but are found to be persuasive. Applicant discusses the differences between transferosomes and liposomes and then argues**

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that transferosomes of EP 0475 160 exhibit a clear solubilization point and points out to claim 1. It is unclear whether applicant is referring to claim 1 of EP or the English equivalent, 6,165,500. Since applicant has already placed on record that EP reference corresponds to US 6,165,500 and since this US patent discloses the same composition, the rejection is applicable. Claims do not reflect the differences argued. With regard to the clear solubilizing point in EP, the examiner points out that instant claims, claim 22 for example, recites, 'if there is a solubilizing point'. This means that claims read on both clear solubilization point as well as 'no solubilization point'. With regard to the more than 0.1 and 99 mol % in the prior art and instant 'less than 0.1 and 99 mol %', the examiner points out to claim 1 of US equivalent which recites 5.5 : 1 to 1 :500 and it would appear that instant broad range falls within this range.

The examiner would reconsider the rejection if applicant provides an English translation of EP and show the differences.

*Claim Rejections - 35 U.S.C. § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22-33 and 49-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 475 160 cited above.

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As pointed out above, EP teaches a composition containing a drug, an amphiphilic lipid and a surfactant in instant amounts and a method of preparation. It is unclear whether the reference teaches all the instant functional parameters. In case they are different, in the absence of showing the criticality, they are deemed to be parameters manipulatable by an artisan to obtain the best possible results.

Applicant's arguments have been fully considered, but are not found to be persuasive. Applicant's arguments once again center around the differences in the mole percentages in the prior art and in instant invention. These arguments are not found to be persuasive since as pointed out above, prior art is suggestive of manipulations of the ratios between the lipid and the solubilizing agent and therefore, one of ordinary skill in the art would be motivated to manipulate its teachings with the expectation of obtaining the best possible product.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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**shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to *G.S. Kishore* whose telephone number is (703) 308-2440.**

**The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M. The examiner can also be reached on alternate Fridays.**

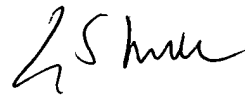
**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, T.K. Page, can be reached on (703)308-2927. The fax phone number for this Group is (703)305-3592.**

**Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [thurman.page@uspto.gov].**

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**All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.**

**Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1235.**



**Gollamudi S. Kishore, Ph. D**

**Primary Examiner**

**Group 1600**

*gsk*

**December 31, 2002**